



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/821,477 | 04/08/2004 | Yuka Hasegawa | P/1909-168 | 1055 |

2352 7590 02/01/2006

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT PAPER NUMBER

2643

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|---------------------------------------|--|
| Office Action Summary | Application No. 10/821,477 | Applicant(s) HASEGAWA, YUKA | |
| | Examiner Melur Ramakrishnaiah | Art Unit 2643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4-8-04/10-18-04, 12-30-05</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (US PAT: 6,515,695, filed 11-8-1999, hereinafter Sato) in view of Nishimura (JP07-115633).

Regarding claims 1 and 13, Sato discloses a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image, comprising: imaging means (15, fig. 1) for shooting an image, a microphone (21, fig. 1) for converting voice and sound into an electric signal, display means (14, fig. 1), for displaying a screen image, a communicating means (17, fig. 1) for communicating a call, a storage means (11, fig. 1) for beforehand storing telephone book table including a telephone number and a reply method with a relationship established there between, and a control means (10, fig. 1) for conducting control at reception of a call from a communicating terminal to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table stored in the storage means (col. 7, line 30 – col. 8, line 34; col. 10, line 1 – col. 11, line 26; col. 14, line 14 – col. 15, line 21; col. 16, line 50 – col. 17, line 47; figs. 1, 2, 4).

Art Unit: 2643

Sato differs from claims 1 and 13 in that he does not teach the following: the reply method including using any one of a camera image, a still image, or a substitute image.

However, Nishimura discloses video telephone system which teaches the following: the reply method including a still image (abstract; paragraphs: 0006, 0010-0016).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Sato's system to provide for the following: the reply method including using any one of a camera image, a still image, or a substitute image as this arrangement would facilitate audio and video message appropriate for the caller as taught by Nishimura, thus facilitating sending appropriate message to the caller suitable for him.

Sato differs from claims 2,14 in that he does not teach the following: telephone book table relates a telephone number of a communicating terminal to a replay method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a replay as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to reply method,

However, Nishimura discloses video telephone system which teaches the following: telephone book table relates a telephone number of a communicating terminal

Art Unit: 2643

to a replay method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a replay as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to reply method (Drawings: 1-8, paragraphs: 0006 – 0011 and see effect of the invention).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Sato's system to provide for the following: telephone book table relates a telephone number of a communicating terminal to a replay method to send a reply as an answering telephone, the control means makes at reception of a call, when an answering reply mode to send a replay as an answering telephone is set in advance, a search through telephone book table and transmits, when the telephone number of the communicating party is related to a reply method as an answering telephone, an image and voice and sound to the communicating terminal according to replay method as this arrangement would provide means for sending a replay message that best matches the telephone number of the calling party as taught by Nishimura.

3. Claims 8-9, 20-21, are rejected under 35 U.S.C 102(b) as being anticipated by Nishimura (JP07-115633).

Regarding claim 8, Nishimura discloses a screen display setting method for use with a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image including imaging means for shooting a

image, a microphone for converting voice and sound into an electric signal, display means for displaying a screen image, and a communicating means for communicating a call, the method comprising: a reply setting step of relating in a telephone book table a telephone number of a communicating terminal to a reply method at reception of a call according to an input from an input means, and a replay step of conducting control at a reception of a call from a communicating terminal to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table (Drawings: 1-8, paragraphs: 0006 – 0016), the reply method including a reply using one of a camera image, still image or substitute image (abstract; paragraphs: 10-16).

Regarding claim 20, Nishimura discloses a screen display setting method for use with a videophone terminal for conducting a call with a communicating terminal by communicating voice and sound and an image including imaging means for shooting a image, a microphone for converting voice and sound into an electric signal, display means for displaying a screen image, and a communicating means for communicating a call, the method comprising: a reply setting step of relating, according to an input from an input means of one videophone terminal selected from the videophone terminals, a telephone number of a communicating terminal to a reply method at reception of a call in a telephone book table by the videophone terminal selected from the videophone terminals, and a reply step of conducting control by the videophone terminal at reception of a call from a communicating terminal to convert an image and voice and

Art Unit: 2643

sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method related to a telephone number of the communicating terminal in the telephone book table (Drawings: 1-8, paragraphs: 0006 – 0016), the reply method including a reply using one of a camera image, still image or substitute image (abstract; paragraphs: 10-16).

Regarding claims 9 and 21, Nishimura further teaches the following: the telephone book table (Drawing: 3) relates a telephone number of a communicating terminal to a reply method of sending a reply as an answering telephone, and the control means, at reception of a call in a state in which the videophone terminal is set to reply as an answering telephone in advance, a search through the telephone book table and transmits, when the telephone number of the communicating terminal of the call is related to a replay method as an answering telephone, an image and voice and sound to the communicating terminal according to the reply method, an answering reply setting step of relating, according to an input means of one videophone terminal selected from the videophone terminals, in a telephone book table a telephone number of a communicating terminal to a reply method to send a reply as an answering telephone to the communicating terminal by the videophone terminal selected from the videophone terminals, and an answering reply step of conducting by the videophone terminal control at reception of a call from a communicating terminal in a state in which the videophone terminal is beforehand set to reply as an answering telephone, to convert an image and voice and sound to be sent from the videophone terminal to the communicating terminal into data according to a reply method as an answering telephone related to a

Art Unit: 2643

telephone number of the communicating terminal in the telephone book table ,

(Drawings: 1-8, paragraphs: 0006 – 0016).

4. Claims 3-7 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Nishimura as applied to claims 1 and 13 above, and further in view of Saiki et al. (JP11-234641, hereinafter Saiki).

The combination differs from claims 3-4, 7 and 15-19 in that it does not teach the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying a still image using an image stored in the storage means.

However, Saiki discloses display device for image of video telephone set which teaches the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into

Art Unit: 2643

the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying a still image using an image stored in the storage means (Drawing 1, paragraphs: 0010 –0038 and 0057).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: the reply method includes a reply using a substitute image expressing a feature of a movement in an image shot by the imaging device by movement of a character beforehand set, and the control means includes a substitute image display control section for converting the image shot by the imaging means into the substitute image, the reply using the substitute image includes a reply using voice and sound, the substitute image display control section converts voice and sound from microphone into voice and sound corresponding to substitute image, the replay method includes a reply using a camera image shot by the imaging means and reply using a still picture, the control means includes camera image display control means for displaying the camera image shot by the imaging means, and a still picture display control means for displaying a still image using an image stored in the storage means as this arrangement would facilitate to communicate with communication partners while keeping the privacy of the

communication partners as taught by Saiki, thus providing a communication arrangement to suite the needs of the users.

Regarding claim 5, the combination teaches the following: the communicating means includes a function to establish a connection to a network, data is obtained for the character via the network from the communicating means and is stored in the storage means (col. 11 lines 20-67 of '695).

5. Claims 10-11, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Saiki.

Nishimura differs from claims 11-12 and 22-23 in that he does not teach the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply using the substitute image includes a reply using voice and sound corresponding to the substitute image.

Saiki teaches the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply using the substitute image includes a reply using voice and sound corresponding to the substitute image (Drawing 1, paragraphs: 0010 –0038 and 0057).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishimura to provide for the following: reply method includes a reply using a substitute image expressing a feature of the movement in image shot by the imaging device by movement of a character beforehand set, reply

Art Unit: 2643

using the substitute image includes a reply using voice and sound corresponding to the substitute image as this arrangement would facilitate to communicate with communication partners while keeping the privacy of the communication partners as taught by Saiki, thus providing a communication arrangement to suite the needs of the users.

6. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Nakajima (JP2003032727A).

Nishimura differs from claims 12 and 24, he does not teach the following: communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means

However, Nakajima teaches the following: communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishimura to provide for the following: communication means includes a function to establish connection to a network, the method further comprising a character obtaining step of obtaining data for character via the network from the communicating means and storing the data in storage means as this arrangement would provide means to obtain required data from an external source as taught by Nakajima, thus facilitating the user to use the data for further processing.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7 and 13-20 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed on 12-5-2005 with respect to claims 8-12 and 20-24 have been fully considered but they are not persuasive.

Rejection of claims 8-9 and 20-21 under 35 U.S.C 102(b) as being anticipated by Nishimura (JP07-115633): regarding rejection of claims 8-9 and 20-21 using the above reference, Applicant argues that "there is no disclosure, teaching, or suggestion of the any one of a camera image or still image or substitute image as a reply method in a reply method, as claimed in independent claims 8 and 20. Regarding this argument, Applicant claim limitations recited in claims 8 and 20 calls for transmitting any one of a camera image or still image or substitute image as a reply method in a reply method. This limitation , contrary to applicant's interpretation of Nishimura reference, is taught by Nishimura because Nishimura is sending still image (reads on stored image) as a reply method (abstract; paragraphs: 0012-0016), thus satisfying the claim limitations of claims 8 and 20.

Rejection of claims 10-11 and 22-23 under 35 U.S.C 103(a) as being obvious over Nishimura in view of Saiki: regarding rejection of claims 10-11 and 22-23 using the above references, Applicants arguments are tied to independent claims 8 and 20 being patentable which are not as explained above in response to applicant's arguments on rejection of claims 8 and 20.

Rejection of claims 12 and 24 as being obvious over Nishimura in view of Nakajima (JP2003032727A): regarding rejection of claims 12 and 24 using the above references, Applicants arguments are tied to independent claims 8 and 20 being patentable which are not as explained above in response to applicant's arguments on rejection of claims 8 and 20.

In light of this rejection of claims 1-24 is maintained.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

Art Unit: 2643

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2643